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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/121,725 07/24/98 VOISIN

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IM62/0721  
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EXAMINER

BECKER, D

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

07/21/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/121,725

Applicant(s)

Voisin

Examiner

Drew Becker

Group Art Unit

1761

☒ Responsive to communication(s) filed on Oct 13, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) 5 and 8-26 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4, 6, and 7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4 and 6-7, drawn to a method of eliminating pathogenic organisms from shellfish, classified in class 426, subclass 410.
  - II. Claims 8-13, drawn to a method of shucking a raw oyster, classified in class 426, subclass 2.
  - III. Claims 14-26, drawn to an apparatus for processing raw food products, classified in class 99, subclass 467.
  - IV. Claim 5, drawn to a raw shellfish product, classified in class 426, subclass 643.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In this case the method of group I is directed to eliminating pathogenic organisms while the method of group II is directed to shucking a raw oyster.

3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice

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another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of group III can be used in a manner not limited to just the method of eliminating pathogenic organisms of group I, for instance the apparatus of group III can be used to shuck raw oysters.

4. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of group III can be used in a manner not limited to just the method of shucking raw oysters of group II, for instance the apparatus of group III can be used to eliminate pathogenic organisms.

5. Inventions I and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of group IV can be made in a manner not limited to that of group I, for instance an irradiation treatment could be used.

6. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In this case the method of group II is directed to shucking raw oysters while the product of group IV is directed to a raw oyster whose pathogenic organisms have been eliminated.

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7. Inventions III and IV are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus of group III can be used to produce a product not limited to that of group IV, for instance a non-food product (ie. surgical instruments) can be treated.
8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
9. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, which is not required for Group III, which is not required for group IV, restriction for examination purposes as indicated is proper.
10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
11. During a telephone conversation with Thomas Keaty on July 13, 1999 a provisional election was made with traverse to prosecute the invention of group I, claims 1-4 and 6-7. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 5 and 8-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pressures of 20,000-50,000 psi to eliminate bacteria in certain raw shellfish, does not reasonably provide enablement for using any hydrostatic pressure for any raw shell fish to eliminate bacteria. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Page 11, lines 10-13 and page 16, lines 15-20 recite the lower pressures used by the applicant are for the purpose of shucking oysters and do not effectively eliminate bacteria in the oysters. US Patent No. 5,593,714 discloses that hydrostatic pressure treatments of 25,000 psi do not eliminate pathogenic bacteria in shellfish (column 6, line 53). Therefore it would be undue experimentation to derive the proper level of pressure to eliminate bacteria in shellfish.

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch [Pat. No. 5,593,714] in view of JP 02257864 A.

Hirsch teaches a method of preserving scallops (column 6, line 53) comprising exposure to hydrostatic pressure of at least 20,000 psi (column 2, line 66), at ambient temperature (column 10, line 2), depositing the seafood in a sealed plastic package with a quantity of fluid (column 3, lines 30 & 62-66), and a pressure treatment of 5 days at 25,000 psi being inadequate to sterilize shellfish (column 6, line 19). Hirsch does not recite a treatment time of 1-15 minutes. JP 02257864 A teach a method of sterilizing bacterial spores by treating food for 5-300 minutes under a pressure of 14,223-142,230 psi (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the pressure and time ranges of JP 02257864 A into the method of Hirsch since Hirsch teaches using pressures of at least 20,000 psi (column 2, line 66) and that the problem with sterilizing seafood is that bacteria found in the ocean live normally at pressures of 21,755 psi (column 6, line 55) and therefore are more resistant to high pressure treatments.


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16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hiltkawsky et al [Pat. No. 5,622,678] teach methods of applying hydrostatic pressure to food products.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703)-305-0300. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:00 pm and every other Friday from 7:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax number for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
David Lacey  
Supervisory Patent Examiner  
Technology Center 1700  
7/16/99

Drew Becker

July 16, 1999